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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,129	04/18/2001	Misaki Ishida	3274-010528	7371

7590

09/10/2003

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EXAMINER

WANG, SHENGJUN

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 09/10/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/837,129

Applicant(s)

ISHIDA ET AL.

Examiner

Shengjun Wang

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on June 5, June 6, June 16, 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 15-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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**DETAILED ACTION**

Receipt of applicants' declaration, and amendments and remarks submitted June 5, 2003, June 6, 2003, and June 16, 2003 is acknowledged.

***Claim Rejections 35 U.S.C. 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hadas et al. (GB 2,259,014, of record), in view of Swift (US 3,598,841, of record), and JP 08337534, and in further view of Machida et al. (IDS AS) and Sarin et al. (IDS, AS) with respect to claims 15-18.

3. Hadas et al. teaches a composition for skin whitening comprising a flavonoid and ascorbic acid or its derivatives, wherein the flavonoid may be a plant extract. (see the abstract). Hadas further teaches that kojic acid enhances the whitening effect of flavonoid and ascorbic acid and its derivative through a synergistic effect (see page 19, lines 17-27). The composition may further comprise other well-known cosmetic ingredients. See the examples.

4. Hadas et al. does not teach expressly the employment of citrus unshiu extract as the source of flavonoid.

5. However, Swift teaches citrus peels is well known to containing significant amount of flavonoids herein employed. See, particularly, column 1, lines 31-35. JP 08337534 teaches that

the organic extract of citrus unshiu is particularly useful for whitening skin. See, particularly, the abstract.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a composition according to Hadas by employ the citrus unshiu extract.

A person of ordinary skill in the art would have been motivated to make a composition according to Hadas by employ the citrus unshiu extract because citrus unshiu extract is known to containing flavonoid herein, and is particularly known for the usefulness as skin whitening agent.

With respect to claim 15-18, which recited a method of preparing the extract, note it would have been an obvious alternative by employing a purified, or concentrated extract, to a crude extract. Purifying or concentrating a composition with known active ingredients is seen as a routine experiment, and would have been within the skill of artisan. See the entire documents of Machida et al. and Sarin et al., wherein flavonoids are concentrated, or purified by similar procedure herein employed, i.e., solvent extraction, and liquid chromatography.

***Response to the Arguments***

Applicants' declaration, amendments and remarks submitted June 5, 2003, June 6, 2003, and June 16, 2003 have been fully considered, but are not persuasive for reasons discussed below.

6. Applicant's arguments with respect to claims 1-3 and 15-18 have been considered but are moot in view of the new ground(s) of rejection.

The declaration under 37 CFR 1.132 filed June 5, 2003 is insufficient to overcome the rejection of claims 1-3, 15-18 based upon Hadas et al. (GB 2,259,014, of record), in view of Swift (US 3,598,841, of recode), and JP 08337534, as set forth above.

Applicant generated data, proffered to obviate prior art teachings, lacks the probative force accorded data generated by independent, disinterested parties. It is well settled patent law "that it is not a difficult matter to carry out a process in such a fashion that it will not be successful and, therefore, the failures of experimenters who have no interest in succeeding should not be accorded great weight" In re Michalek, 74 USPQ 108, at 109 citing Bullard Company et al v. Coe, 147 F.2d. 568, 64 USPQ 359. Therefore, the declaration does not provide sufficient evidence to establish unexpected benefit over citrus extract in general. Further, the employment of the particular citrus are obvious in view of JP 08337534 as discussed above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Patent Examiner

Shengjun Wang  
September 5, 2003